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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,216	03/31/2004	Leon Edward Gregg	ROC920040029US1	7113
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IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER ELAND, SHAWN	
			ART UNIT 2188	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,216	Applicant(s) GREGG ET AL.	
	Examiner SHAWN ELAND	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-10,12-15,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,12-15,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/16/09 has been entered.

Status of Claims

Claims 1 – 2, 7 – 10, 12 – 15, 19, & 21 are pending in the Application.

Claims 1, 13, 19, & 21 have been amended.

Claims 3 – 6, 11, 16 – 18, 20, & 22 are cancelled.

Claims 1 – 2, 7 – 10, 12 – 15, 19, & 21 are rejected.

Response to Amendments

Applicant's amendments and arguments filed on 01/16/09 in response to Office action filed 10/16/08 have been fully considered, but they are not persuasive. Therefore, the rejections made in the previous Office action are maintained and restated below, with changes needed to address the amendments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Leonhardt* et al. (US 5,164,909), in view of *Hwang* (US 6,058,082) and *Korngiebel* (US 5,416,914).

In regard to claim 1, Leonhardt discloses:

storing a first media technology indicator with predefined media information to identify a required technology for each media (Fig. 14 Volume Attributes 1401; data storage image includes definition of the type of media Col. 13 Lines 13-15);

storing a second device technology indicator to describe each said device in the robotic media library (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

identifying an operation request to the robotic media library (Fig. 11 user requests access 1101);

responsive to said operation request, checking for multiple device types in the robotic media library (Fig. 11 generate prioritized list of available media drives 1107);

responsive to identifying the multiple device types in the robotic media library and a default value for said first indicator, selecting a first device type (Fig. 11 select media type

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1106) **and placing media in said selected device** (Fig. 11 mount media element on selected drive 1111); **and**

selecting a device of said selected first device type (Fig. 11 select specific media drive 1110).

Though Leonhardt further discloses the steps of **checking for a successful operation, continuing with a requested operation** (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation), and **loading the media for said selected device for subsequent uses of the media** (Fig. 11 mount media element on selected drive 1111) he does not expressly disclose **responsive to an unsuccessful operation, selecting a next device type**.

Hwang however teaches detecting an error and determining the type of media based on comparison (Col. 1 Lines 49-62; specifically responsive to detecting an error begins trying the next type of media as in Fig. 5 i.e. item 501 is test that results in determining either no disc as in 502 or try next media as in item 503 which is a test for determining if media is a multi-layered DVD as in item 304).

Leonhardt and Hwang are from the same field of endeavor that is the art of handling multimedia devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include a method of discriminating media as in Hwang in the system of Leonhardt in order to quickly discriminate the type of storage being used (Hwang Col. 1 Lines 32-39).

Additionally note, though Leonhardt does not expressly disclose selecting the newest device type in the robotic media library for said first device type, Examiner took official notice

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in the previous Office action (mailed 7 June 2007) that selecting the newest type of media as the first type is an obvious design choice in view of the need to write data on newly implemented media in order to phase out older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice...".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

The combination of Leonhardt and Hwang does not teach **responsive to a successful operation, updating said first media technology indicator for the media for said selected device**. However, Korngiebel, in a very similar disclosure, teaches a robotic library media system (figure 1) that changes device tables which allows a particular storage media to be used by several different storage devices (col. 2, lines 52 – 58; col. 3, lines 1 – 6). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify

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the Leonhardt/Hwang combination by implementing Korngiebel's changeable table system in order to increase the flexibility of the system (col. 1, lines 23 - 25).

As for claim 2, Leonhardt discloses **the steps responsive to said operation request, of setting a device type from said predefined media information** (Fig. 11 review data file for attributes and constraints 1104 results in select media type 1106).

As for claim 12, Leonhardt discloses **the steps of storing said second indicator with predefined information for each said device in said robotic media library** (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

As for claims 13-15, Leonhardt **discloses a computer-readable medium encoded with a computer program product** (automated cartridge library software Fig. 1 Item 110, Col. 3 Line 30) **for implementing device selection in a robotic media library in a computer system, said computer program product including instructions executed by the computer system to cause the computer system to perform the steps recited in claims 1-2**. As such these claims are rejected based on the same rationale as claims 1-2, *supra*. Additionally note, Leonhardt discloses the step of **selecting said first device type as including the steps of storing a value representing said first device type for said first indicator** (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

As for claim 19, Leonhardt discloses **a computer-readable medium encoded with a stored media information** (Fig. 14 Volume Attributes 1401);

said computer-readable medium encoded with a first indicator stored with predefined media information to identify a required technology for each media (Fig. 14

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Volume Attributes 1401; data storage image includes definition of the type of media Col. 13 Lines 13-15);

said computer-readable medium encoded with a device selection control program, said device selection control program stores a second indicator to describe each said device in the robotic media library (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68);

said device selection control program including instructions executed by the computer system to cause the computer system to perform the steps (automated cartridge library software Fig. 1 Item 110, Col. 3 Line 30) **of identifying an operation request to the robotic media library; responsive to said operation request, for checking for multiple device types in the robotic media library** (Fig. 11 generate prioritized list of available media drives 1107); **responsive to identifying the multiple device types in the robotic media library and a default value for said first indicator, for selecting a first device type** (Fig. 11 select media type 1106);

selecting a device of said selected first device type and placing media in said selected device (Fig. 11 select specific media drive 1110 and mount the media on the selected drive, element 1111).

Though Leonhardt further discloses the steps of **checking for a successful operation, continuing with a requested operation** (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation), and **loading the media for said selected device for subsequent uses of the media**

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(Fig. 11 mount media element on selected drive 1111) he does not expressly disclose **responsive to an unsuccessful operation, selecting a next device type**.

Hwang however teaches detecting an error and determining the type of media based on comparison (Col. 1 Lines 49-62; specifically responsive to detecting an error begins trying the next type of media as in Fig. 5 i.e. item 501 is test that results in determining either no disc as in 502 or try next media as in item 503 which is a test for determining if media is a multi-layered DVD as in item 304).

Leonhardt and Hwang are from the same field of endeavor that is the art of handling multimedia devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include a method of discriminating media as in Hwang in the system of Leonhardt in order to quickly discriminate the type of storage being used (Hwang Col. 1 Lines 32-39).

Additionally note, though Leonhardt does not expressly disclose selecting the newest device type in the robotic media library for said first device type, Examiner took official notice in the previous Office action (mailed 7 June 2007) that selecting the newest type of media as the first type is an obvious design choice in view of the need to write data on newly implemented media in order to phase out older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713,

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60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice...".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

The combination of Leonhardt and Hwang does not teach **responsive to a successful operation, updating said first media technology indicator for the media for said selected device**. However, Korngiebel, in a very similar disclosure, teaches a robotic library media system (figure 1) that changes device tables which allows a particular storage media to be used by several different storage devices (col. 2, lines 52 – 58; col. 3, lines 1 – 6). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the Leonhardt/Hwang combination by implementing Korngiebel's changeable table system in order to increase the flexibility of the system (col. 1, lines 23 - 25).

As for claim 21, the combination of Leonhardt and Hwang teach **selecting a second device of said selected next device type, placing media in said selected second device and checking for successful operation**, and Leonhardt discloses **wherein said device selection control program responsive to media being placed in said selected device, performs checking for successful operation, and responsive to said successful operation, continues with a requested operation** (the retrieved media is loaded onto the drive element where it is

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read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation and concluding the requested operation is a natural result).

As for claim 7, though Leonhardt does not expressly disclose **selecting the oldest device type in the robotic media library for said first device type**, Examiner took Official notice in the previous Office action (mailed 7 June 2007) that selecting the oldest type of media as the first type is an obvious design choice in view of Leonhardt. As stated previously, a skilled artisan would recognize the need to select the next older medium in order to quickly locate data, which has a higher likelihood of being stored in older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice....".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

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As for claim 8, Leonhardt discloses **the steps of selecting a second device of said selected next device type, placing media in said selected second device** (Leonhardt Fig. 11 mount media element on selected drive 1111 will still naturally result in the event a second drive is chosen).

As for claim 9, the rejection of claim 1 above addressing the limitations presented here (with regards checking for successful operation, and selecting a next device type responsive to an unsuccessful operation, therefore this claim is rejected based on the same rationale as discussed in claim 1.

As for claim 10, Leonhardt discloses **the steps of checking for successful operation, and responsive to said successful operation, continuing with a requested operation** (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation and concluding the requested operation is a natural result).

Response to Arguments

Applicant's arguments filed 01/16/09 have been fully considered but they are not persuasive.

Applicant argues *the prior art does not teach the newly amended claims*.

Applicant has added "continuing with a requested operation" after a successful operation.

Examiner would like to ask, upon reading of Leonhardt, including Fig. 11 elements 1101 & 1111, just what the Applicant expects to happen after the media element is mounted. If the user requests access to a file (element 1101), whether it is to read or write, wouldn't the system logically continue the operation upon successful loading?

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In response to applicant's argument that the prior art does not teach “loading the media for said selected device for subsequent uses of the media,” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Examiner's Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn Eland whose telephone number is (571) 270-1029. The examiner can normally be reached on MO - TH, & every other FR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hyung S. Sough/
Supervisory Patent Examiner, Art Unit 2188
03/20/09

/Shawn Eland/
Examiner, Art Unit 2188
3/23/2009